Appl. No.:   09/483,063
Amdt. dated December 30, 2003
Reply to Office action of October 14, 2003

REMARKS/ARGUMENTS

Applicants received the Office Action dated October 14, 2003, in which the Examiner: (1) objected to the drawings; (2) rejected claims 1-2, 5-7, 15, 17, and 19 as obvious over O'Connor (US Patent No. 5,894,571) in view of Arai (translation of Japanese Application No. JP 10-011282); (3) rejected claims 3-4 and 18 as being obvious O'Connor in view of Arai and Mullor et al. (US Patent No. 6,411,941); (4) rejected claims 8-9, 12-14, and 16 as obvious over O'Connor in view of Arai and Beetcher et al. (US Patent No. 5,933,497); and (5) rejected claim 10 and 11 as obvious over O'Connor in view of Arai, Mullor, and Beetcher. In this Response, Applicants amend the specification, amend claims 1, 8, and 15-17, 19, and add claims 20-25. Therefore, claims 1-25 are pending. Based on the amendments and the arguments contained herein, Applicants respectfully request reconsideration and allowance of the pending claims.

A.   Drawing Objections

The Examiner objected to the drawings because several reference numbers used in the specification did not correspond with reference numbers used in the drawings. Applicants submit that the drawings use correct reference numbers and that the specification has a few typographical errors. Accordingly, Applicants amend the specification to correct the typographical errors to thereby make the reference numbers of the specification match the reference numbers used in the drawings.

B.   Claim Rejections

O'Connor teaches a manufacturing system that matches a built from order computer system with a built from order CD-ROM containing software. Both the computer system and the CD-ROM are assigned a common an identification (ID) number. Of relevance to the claims, the CD-ROM not the software contained thereon is assigned the ID number. The software of the built from order CD-ROM is loaded onto the computer system that has the same identification number. The computer system and the corresponding CD-ROM are then shipped to a customer (see Figures 1-3 and columns 4-6). The ID number permits software

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purchased by the customer to be loaded in the computer specified by the customer.

Arai teaches a computer system 2 having storage areas 23-25, 281-283 that store installation IDs, software IDs, and version IDs. Arai further teaches a software medium 1 that stores the same IDs. When the software on the medium 1 is to be installed, the IDs stored in the medium 1 are compared with the IDs stored in the computer system 2. If there are no IDs stored in the computer system 2 or if certain combinations of IDs (e.g., same product, but older version) are stored in the computer system 2, the software of the medium 1 is installed on the computer system 2 (see Abstract, paragraphs [0012]-[0039]).

Claim 1 was amended to clarify language in the claim and to remove references to the "control module" limitation, which is believed to be unnecessary. Claim 1 was not amended to further distinguish the claim as patentable over any prior art references.   Amended claim 1 requires, among other features, "a digital storage device containing at least one software product, said software product having been assigned a unique identifier," and a "computer system" having "a non-volatile memory" that stores "at least one identifier corresponding to the identifier of said software product in said non-volatile memory." Further, "the software product having an identifier which corresponds to the at least one identifiers stored in the non-volatile memory is loaded onto said computer system." The Examiner correctly states that O'Connor doesn't teach a software product having a unique ID and relies on Arai instead. Combining O'Connor and Arai as suggested by the Examiner is improper for at least two reasons. First, the combination would defeat the purpose of O'Connor which is to find the correct computer on which to load the software contained on the CD-ROM. Instead, per Arai, the software on O'Connor's CD-ROM would be installed on all computers without matching ID's (i.e., on all the wrong computers). Second, there is no benefit to modifying O'Connor per Arai to assign a unique ID to each and every software product on O'Connor's CD-ROM. In O'Connor, all the software on the CD-ROM is correct and needs to be loaded. The only issue is to find the correct computer on which to load the CD-ROM's software. Thus, differentiating

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individual software products on the CD-ROM would be useless to the invention of O'Connor and, moreover, improperly uses Applicants' contribution in hindsight. For at least these reasons, Applicants submit that claim 1 and all claims that depend from claim 1 are allowable.

Claim 8 was amended to clarify language in the claim and to remove references to the "control module" limitation, which is believed to be unnecessary. Claim 8 was not amended to further distinguish the claim as patentable over any prior art references. Amended claim 8 requires, among other features, "a digital storage device containing a plurality of software modules containing at least one software product...each of said software modules having been assigned a unique identifier." Further, a "computer system storing at least one identifier in said nonvolatile memory which corresponds to at least one identifier of said software modules." Further, "the at least one software product from the software module having an identifier which corresponds to the identifier stored in the non-volatile memory is loaded onto said computer system." In rejecting claim 8, the Examiner combined O'Connor, Arai, and Beetcher (as teaching software modules). However, as previously explained, combining O'Connor and Arai as suggested by the Examiner is improper. Therefore, a combination of O'Connor, Arai, and Beetcher would likewise be improper. For at least these reasons, Applicants submit that independent claim 8 and all claims that depend from claim 8 are allowable.

Claim 15 was amended to replace all references to "software" with "software products." Claim 15 was not amended to further distinguish the claim over any prior art references. Claim 15 requires, among other features, "assigning a unique identifier for each software product in" a "digital storage device", and writing an "identifier of each custom-ordered software product into the non-volatile memory of" a "computer system." Further, "comparing the at least one identifier in said non-volatile memory with the unique identifiers of the custom-ordered software products", and "installing the custom-ordered software products onto the hard disk of the computer system only if one of the identifiers in said non-volatile memory matches the identifier of the custom-ordered software

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products." For the reasons explained above, combining O'Connor and Arai is improper. For at least these reasons, Applicants submit that independent claim 15 and all claims that depend from claim 15 are allowable.

C.   New Claims

Claim 20 requires, among other features, "a processor" and "storage coupled to the processor and containing a plurality of software identifiers." Further, "the processor is adapted to install those software products...that have software identifiers that match software identifiers stored in the system's storage." Applicants cannot find a teaching or suggestion of all of the limitations of claim 20 in the art cited by the Examiner. For at least this reason, Applicants submit that independent claim 20 and all claims that depend from claim 20 are allowable.

Claim 24 requires, among other features, "comparing an identifier stored in a memory with identifiers of a plurality of software products" and "installing each software product in a computer system only if the identifier of a software product matches an identifier stored in the computer" and "after said installing each software product, adding one or more additional identifiers into the memory." Applicants cannot find a teaching or suggestion of these limitations in the art cited by the Examiner. For at least this reason, Applicants submit that independent claim 24 and all claims that depend from claim 24 are allowable.

CONCLUSIONS

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art which have yet to be raised, but which may be raised in the future.
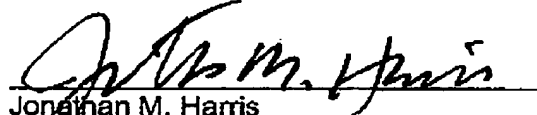
If any fees or time extensions are inadvertently omitted or if any fees have been overpaid, please appropriately charge or credit those fees to Hewlett-

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Packard Company Deposit Account Number 08-2025 and enter any time extension(s) necessary to prevent this case from being abandoned.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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